



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,246	12/13/2000	Peter S. Lu	020054000311	8356

20350 7590 01/11/2002

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

BUNNER, BRIDGET E

ART UNIT PAPER NUMBER

1647

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/737,246

Applicant(s)

LU ET AL.

Examiner

Bridget E. Bunner

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - A. Claims 1-4, 6-15, and 30, drawn to an isolated CLASP-3 polynucleotide, an expression vector, a host cell system, and a method of producing an CLASP-3 polypeptide, classified in class 536, subclass 23.1.
  - B. Claims 5, 16-22, and 30, drawn to an isolated CLASP-3 polypeptide, classified in class 530, subclass 350.
  - C. Claims 23-25 and 30, drawn to an isolated antibody that specifically binds a polypeptide and a hybridoma capable of secreting an antibody, classified in class 530, subclass 387.1.
  - D. Claim 26, drawn to a method of identifying a compound or agent that binds a CLASP-3 polypeptide comprising contacting a CLASP-3 polypeptide with the compounds and detecting the presence of a complex, classified in class 435, subclass 4, for example.
  - E. Claim 27, drawn to a method of detecting a CLASP-3 polypeptide comprising contacting the sample with an antibody and determining whether a complex has been formed, classified in class 435, subclass 7.1.
  - F. Claim 28, drawn to a method of detecting a CLASP-3 polypeptide in a sample comprising contacting the sample with a polynucleotide and determining whether a hybridization complex has been formed, classified in class 435, subclass 6.
  - G. Claim 29, drawn to a method of detecting a CLASP-3 nucleotide in a sample comprising using a polynucleotide in an amplification process and determining whether a specific amplification product has been formed, classified in class 435, subclass 6.
  - H. Claims 31-33, drawn to a method of inhibiting an immune response in a subject comprising interfering with the expression of a CLASP-3 gene, interfering with the ability of a CLASP-3 protein to bind another cell, and interfering with the ability of a CLASP-3 protein to bind another protein, classified in class 435, subclass 4.
  - I. Claim 34, drawn to a method of inhibiting an immune response in a subject comprising administering to the subject a therapeutically effective amount of an

Art Unit: 1647

antibody which specifically binds a polypeptide, classified in class 424, subclass 139.1.

- J. Claims 35-37, drawn to a method of preventing or treating a CLASP-3-mediated autoimmune disease comprising administering to a subject in need thereof a therapeutically effective amount of a polynucleotide, classified in class 514, subclass 44.
- K. Claims 35-37, drawn to a method of preventing or treating a CLASP-3-mediated autoimmune disease comprising administering to a subject in need thereof a therapeutically effective amount of a polypeptide, classified in class 512, subclass 2.
- L. Claims 35-37, drawn to a method of preventing or treating a CLASP-3-mediated autoimmune disease comprising administering to a subject in need thereof a therapeutically effective amount of an antibody, classified in class 424, subclass 130.1.

The inventions are distinct, each from the other because of the following reasons:

- a. Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups A-C are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Further, the protein of Group B can be prepared by processes which are materially different from recombinant DNA expression of Group A, such as by chemical synthesis, or by isolation and purification from natural sources. Additionally, the DNA of Group A can be used other than to make the protein of Group B, such in gene therapy or as a probe in nucleic acid hybridization assays. The protein of Group B can be used in materially different methods other than to make the antibody of Group C, such as in therapeutic or diagnostic methods (e.g., in screening). Finally, although the antibody of Group C can be used to obtain the DNA of Group A, it can also be used in materially different methods, such as in various

diagnostic (e.g., as a probe in immunoassays or immunochromatography), or therapeutic methods.

- b. Similarly, although there are no provisions under the section for “Relationship of Inventions” in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods constitute patentably distinct inventions for the following reasons. Inventions D-L are different methods because they require different ingredients, process steps, and endpoints. Groups D-L are different methods requiring different method steps, wherein each is not required, one for another. For example, Invention D requires search and consideration of identification of a compound or agent by contacting a CLASP-3 polypeptide with the compound or agent and detection of a complex, which is not required by the other inventions. Invention E requires search and consideration of detection of a CLASP-3 polypeptide in a sample by contacting the sample with an antibody and measuring complex formation, which is not required by the other inventions. Invention F requires search and consideration of detection of a CLASP-3 polypeptide in a sample by contacting the sample with a polynucleotide and measuring hybridization complex formation, which is not required by the other inventions. Invention G requires search and consideration of detection of a CLASP-3 nucleotide in a sample by utilizing an amplification process, which is not required by the other inventions. Invention H requires search and consideration of inhibition of an immune response in a subject and interference of CLASP-3 gene expression, CLASP-3 cell binding, and CLASP-3 protein binding, which is not required by the other inventions. Invention I requires search and consideration of inhibition of an immune response in a subject and efficacy of therapy of antibody administration, which is not required by the other inventions. Invention J requires search and consideration of efficacy of therapy of polynucleotide administration for the treatment and prevention of a CLASP-3 mediated disease, which is not required by the other inventions. Invention K requires search and consideration of efficacy

of therapy of polypeptide administration for the treatment and prevention of a CLASP-3 mediated disease, which is not required by the other inventions.

Invention L requires search and consideration of efficacy of therapy of antibody administration for the treatment and prevention of a CLASP-3 mediated disease, which is not required by the other inventions.

- c. Inventions A and F/G/J are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used in materially different processes, such as DNA purification.
- d. Inventions B and D/H/K are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used as an antigen for the production of antibodies.
- e. Inventions C and E/I/L are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used in materially different processes, such as immunochromatography or immunopurification.

- f. Inventions A and D/E/H/I/K/L are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions of Groups A and D/E/H/I/K/L are unrelated product and methods, wherein each is not required, one for another. For example, the claimed methods of Inventions D/E/H/I/K/L do not recite the use or production of the polynucleotide of Invention A.
- g. Inventions B and E/F/G/I/J/L are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions of Groups B and E/F/G/I/J/L are unrelated product and methods, wherein each is not required, one for another. For example, the claimed methods of Inventions E/F/G/I/J/L do not recite the use or production of the polypeptide of Invention B.
- h. Inventions C and D/F/G/H/J/K are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups C and D/F/G/H/J/K are unrelated product and methods, wherein each is not required, one for another. For example, the claimed methods of Inventions D/F/G/H/J/K do not recite the use or production of the antibody of Invention C.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification, separate search requirements, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.



Art Unit: 1647

This application contains claims directed to the following patentably distinct species of the claimed invention:

A method of inhibiting an immune response in a subject comprising interfering with the ability of a CLASP-3 protein to bind another cell wherein the cell is:

- i. a T cell
- ii. a B cell

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-32 and 36-39 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the



Art Unit: 1647

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

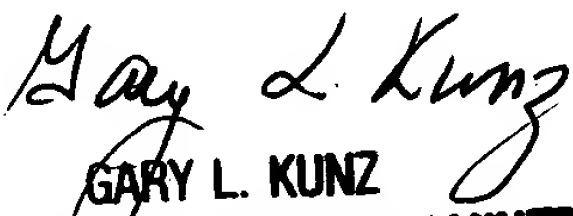
**If Applicant selects Invention H, one species from the cell type group must be chosen to be fully responsive.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bridget E. Bunner whose telephone number is (703) 305-7148. The examiner can normally be reached on 8:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (703) 308-4623. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

BEB  
Art Unit 1647  
January 10, 2002

  
GARY L. KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600